Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JURGEN REINOLD, DAVID KNAPPENBERGER, MATHEW CUCCHI[illegible], JACK SCOTT GERANEN, JEFF LEE and MICHAEL E. WILL[illegible]

Appeal No. 2004-0427
Application No. 09/071,046

ON BRIEF

Before GROSS, LEVY, and MACDONALD, ***Administrative Patent Judges.***

MACDONALD, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-30.

Invention

Appellants' invention relates to a method and system for distributing digital audio and/or video signals in the form of a digital bitstream to an analog wireline device. The digital audio signal may come from a number of possible sources and the

digital audio bitstream may be encoded in any of a plurality of encoding methods. Also, the digital video signal may come from a number of possible sources and the digital video bitstream may be encoded in any of a plurality of encoding methods. Appellants' specification at page 3, lines 22-24; page 9, lines 21-24; page 10, lines 23-25; page 11, lines 21-28; and page 13, lines 5-9.

Claim 1 is representative of the claimed invention and is reproduced as follows:

1. A system for distributing audio content of a digital audio signal to an analog wireline device, comprising:

an audio input interface receiving the digital audio signal from a plurality of sources and identifying an audio bitstream, wherein the audio bitstream comprises audio data based on a plurality of encoding methods corresponding to the plurality of sources;

an audio decoding unit connected to the audio input interface and decoding the audio bitstream;

an audio digital to analog converter connected to the audio decoding unit and converting the audio bitstream to an analog audio signal; and

an audio output interface connected to the audio digital to analog converter and distributing the analog audio signal to the analog wireline device.

References

The references relied on by the Examiner are as follows:

Tsumori et al. (Tsumori)	5,650,827	Jul. 22, 1997
Schulhof et al. (Schulhof)	5,841,979	Nov. 24, 1998 (filed May 7, 1996)
Schein et al. (Schein)	6,002,394	Dec. 14, 1999 (filed Apr. 11, 1997)

Rejections At Issue

Claims 1-5, 9-13, 16-18 and 21-30 stand rejected under 35 U.S.C. § 102 as being anticipated by Tsumori.

Claims 6, 14, and 19 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Tsumori and Schein.

Claims 7, 8, and 15 stand rejected under 35 U.S.C. § 103 as being obvious over the combination of Tsumori and Schulhof.

Claim 20 stands rejected under 35 U.S.C. § 103 as being obvious over the combination of Tsumori and Schein and Schulhof.

Throughout our opinion, we make references to the Appellants' briefs, and to the Examiner's Answer for the respective details thereof.[1]

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellants and the Examiner, for the reasons stated ***infra***, we

[1]Appellants filed an appeal brief on March 25, 2003. The Examiner mailed out an Examiner's Answer on June 17, 2003.

reverse the Examiner's rejection of claims 1-5, 9-13, 16-18 and 21-30 under 35 U.S.C. § 102, and we reverse the Examiner's rejection of claims 6-8, 14, 15, 19, and 20 under 35 U.S.C. § 103.

We also use our authority under 37 CFR § 41.50(b) to enter a new ground of rejection of claims 1-30. The basis for this is set forth in detail below.

For purposes of this appeal, the claims stand or fall together with their grounds of rejection as four groupings as Appellants have stated that they offer no other grouping of claims. The claims are grouped as follows:

Claims 1-5, 9-13, 16-18 and 21-30, as Group I;

Claims 6, 14, and 19, as Group II;

Claims 7, 8, and 15, as Group III; and

Claim 20 as Group IV.

See page 3 of the brief. Furthermore, Appellant argues each group of claims separately and explains why the claims of each group are believed to be separately patentable. See pages 3-11 of the brief. Appellants have fully met the requirements of 37 CFR § 1.192 (c)(7) (July 1, 2002) as amended at 62 Fed. Reg. 53169 (October 10, 1997), which was controlling at the time of Appellants' filing of the brief. 37 CFR § 1.192 (c)(7) state:

> *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellants' claims as standing or falling together in the four groups noted above, and we will treat:

Claim 9 as a representative claim of Group I;

Claim 14 as a representative claim of Group II;

Claim 15 as a representative claim of Group III; and

Claim 20 as a representative claim of Group IV.

If the brief fails to meet either requirement, the Board is free to select a single claim from each group and to decide the appeal of that rejection based solely on the selected representative claim. ***In re McDaniel***, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). ***See also In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

I. Whether the Rejection of Claims 1-5, 9-13, 16-18 and 21-30 Under 35 U.S.C. § 102 is proper?

It is our view, after consideration of the record before us, that the disclosure of Tsumori does not fully meet the invention as recited in claims 1-5, 9-13, 16-18 and 21-30. Accordingly, we reverse.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. ***See In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 9, Appellants argue at page 4 of the brief, "Tsumori et al. discloses only a single source, HDTV, from which a digital signal is received. The other sources disclosed by Tsumori et al. provide analog signals," and "Tsumori et al. further discloses . . . a JSB decoder to descramble the signal (where descrambling inherently refers to an analog signal)." Appellants argue at page 5 of the brief, "[w]hile the HDTV source may have more than one channel available, the HDTV from which the signal originates is still only a single source." Also, Appellants argue at page 5 of the brief, "the HDTV source disclosed by Tsumori et al. uses only one

type of encoding method, not a plurality of encoding methods as claimed by Appellants."

The Examiner responds at page 11 of the answer that Tsumori teaches there are plural sources for the HDTV signals and cites to Tsumori at column 4, line 57, through column 5, line 12. The Examiner also responds that Tsumori teaches encoding the video signals using plural encoding techniques at column 5, lines 24-34, and thus meets the limitation of claim 9.

Now, the question before us is, what would Tsumori have taught to one having ordinary skill in the art? To answer this question we find the following facts:

1. Tsumori states at column 10, lines 13-16 that an "ordinary broadcast program" is processed via video processor circuit 24 and audio circuits 25 and 26.

2. Tsumori states at column 10, lines 16-20 that a "high-definition broadcast program" is audio and video processed via MUSE down-converter 51.

3. Tsumori teaches at figure 1 that audio circuit 25 processes digital audio signals as circuit 26 performs a digital to analog conversion on the output of audio circuit 25.

4. Tsumori at column 4, line 57, through column 5, line 12, teaches that processing audio and video signals can come from a plurality of sources.

5. Tsumori teaches encoding the video signals using plural encoding techniques at column 5, lines 24-34.

6. Tsumori is silent as to whether the HDTV processing is performed via analog or digital processing.

7. Tsumori is silent as to whether MUSE down-converter 51 performs analog or digital processing.

8. Tsumori is silent as to whether video processor circuit 24 performs analog or digital processing.

9. Tsumori is silent as to whether JSB decoder 52 performs analog or digital processing.

We find Appellants arguments that HDTV is a single source and that HDTV uses only one encoding technique to be unpersuasive (see facts 4 and 5 above). Also, while we agree that the UHF/VHF and VTR signal sources are inherently analog, we find Appellants arguments that Tsumori teaches that all sources other than the HDTV provide analog signals to be unpersuasive (see fact 8 above). Further, we find Appellants argument that Tsumori's JSB inherently descrambles an analog signal to be unpersuasive (see fact 9 above). We find that Tsumori is silent as to the analog or digital nature of the BS, HDTV, MUSE, JSB, and video processor circuit 24 video signals being processed. These signals are all conventionally known to be implemented in either analog or digital. See for example Nagasawa et al. 6,055,357 at column 11, lines 1-3, and Geer et al. 6,788,882 at column 4, lines 10-15. Although we disagree with Appellants on the point of a number of Tsumori's signals being inherently analog, we agree with Appellants' underlying point that Tsumori fails to teach that these signals are digital. While it might be

obvious in the extreme to implement items 22, 23, 24, 51, and 52 of Tsumori's figure 1 as either digital or analog signal processing, we find that Tsumori is silent as to their choice of the method of implementation for these signals.

We note that Appellants have erroneously admitted that Tsumori teaches digital HDTV. We would be inclined to hold Appellants to that admission except that they have made specific arguments about the analog nature of the JSB converter processing and its relationship to the HDTV signal that are in conflict with the admission. Should there be further prosecution of this application or a continuation thereof, we strongly recommend that the Examiner introduce references to show that it is known that the various circuits, signals, and encoding of Tsumori can be implemented in either digital or analog forms. Also, we recommend the Examiner discuss the desirability of the digital implementations.

We agree with the Examiner's positions that, Tsumori teaches there are plural sources for the HDTV signals and teaches encoding the video signals using plural encoding techniques. However, we disagree with the Examiner that this meets the limitation of independent claim 9, which requires "a plurality of encoding methods corresponding to the plurality of sources." The Examiner has not shown that Tsumori teaches there is a

correspondence between a source and an encoding method (or sources and methods) as required by claim 9.

Therefore, the Examiner has failed to meet the initial burden of establishing a ***prima facie*** case of anticipation and we will not sustain the Examiner's rejection under 35 U.S.C. § 102.

II. Whether the Rejection of Claims 6, 14, and 19 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 6, 14, and 19. Accordingly, we reverse.

With respect to dependent claim 14, we note that the Examiner has relied on the Schein reference solely to teach "local digital storage" [answer, page 8]. The Schein reference in combination with Tsumori fails to cure the deficiencies of Tsumori noted above with respect to claim 9. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

III. Whether the Rejection of Claims 7, 8, and 15 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill

in the art the obviousness of the invention as set forth in claims 7, 8, and 15. Accordingly, we reverse.

With respect to dependent claim 15, we note that the Examiner has relied on the Schulhof reference solely to teach "a text to speech application", "a digital musical instrument", and "a digital camera." [answer, page 9]. The Schulhof reference in combination with Tsumori fails to cure the deficiencies of Tsumori noted above with respect to claim 9. Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

IV. Whether the Rejection of Claim 20 Under 35 U.S.C. § 103 is proper?

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claim 20. Accordingly, we reverse.

With respect to dependent claim 20 that depends from claim 19, we note that the Examiner has relied on the Schulhof reference solely to teach "a digital camera" [answer, page 10]. The Schulhof reference in combination with Tsumori and Schein fails to cure the deficiencies of Tsumori and Schein noted above with respect to claim 19. Therefore, we will not sustain the

Examiner's rejection under 35 U.S.C. § 103 for the same reasons as set forth above.

V. Rejection of Claims 1-30 Under 37 CFR § 41.50(b).

We make the following new grounds of rejection using our authority 37 CFR § 41.50(b).

Claims 1-30 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

All of the independent claims have been amended to include the limitation of "a plurality of encoding methods corresponding to the plurality of sources." This limitation requires a relationship (correspondence) between a source and an encoding method that was not present in the specification as originally filed. Rather, the original specification at a number of locations recites, "based on any number of possible encoding methods" (see page 10, lines 23-24, and page 13, lines 5-6).

We find that the language used in the specification as originally filed specifically indicates that there is no correspondence between sources and encoding methods. Rather, any

number of appropriate encoding methods may be used for any source.

Conclusion

In summary, we have not sustained the rejection under 35 U.S.C. § 102 of claims 1-5, 9-13, 16-18 and 21-30; and we have not sustained the rejection under 35 U.S.C. § 103 of claims 6-8, 14, 15, 19, and 20.

We have entered a new ground of rejection against claims 1-30 under 37 CFR § 41.50(b).

As indicated ***supra***, this decision contains a new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, by final rule notice, 69 Fed. Reg 49960, 50008 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21, 61 (September 7, 2004)). 37 CFR § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(b) (amended effective September 13, 2004)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner . . .

(2) Request that the proceeding be reheard under 37 CFR § 41.52 by the Board upon the same record . . .

REVERSED; 37 CFR § 41.50(b)

ANITA PELLMAN GROSS)
Administrative Patent Judge)
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STUART S. LEVY) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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